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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,438	09/25/2003	Lars Severinsson	03370-P0057A	5539

24126 7590 06/17/2004

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EXAMINER

BUTLER, DOUGLAS C

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

10/670,438

Applicant(s)

SEVERINSSON ET AL.

Examin r

Douglas C. Butler

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The preliminary amendment filed May 27, 2004 has been entered.
2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims do not appear to harmonize with U.S. practice. There are no clear antecedent bases in the claims for numerous elements such as "the wear" of claim 1, line 1; "the lining material" of claim 1, line 1; "the end" of claim 1, line 2; "the brake disc" of claim 1, lines 3-4. The last five lines of claim 1 are vague and ambiguous. One of the "code parts" is a continuously rotating "code wheel" as recited in claim 1, lines 6-7 but the structure of "the other code part" is unclear in view of the phrase "in the form of a code rack, a sleeve, etc. which is moved in a linear fashion and/or one or more code wheels". What is covered by the last five lines of claim 1 is imprecise and unclear. What is claimed? A code rack? A sleeve? What does "etc" refer to? More "code wheels"? The use of "and/or" obscures the claimed invention.

There are no clear antecedent bases for "it" of claim 11, line 2, claim 14, line 2.

4. "PCB" in the claims should be changed to -- printed circuit board (PCB) --.
- 4a. Page 11, line 4 "tough" should be -- though --.
5. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

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6. All submitted prior art and the Search Report have been considered.

7. Claims 1-¹⁴~~17~~ would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Note that the indication of allowable subject matter is based upon the features, which are presently found in the claims. In overcoming the above rejection, should applicants choose to delete features, which are presently in the claims, this indication of allowable subject matter may no longer apply. The examiner therefore suggests that applicants overcome the above rejection under the second paragraph of 35 U.S.C. § 112 by amending the claims to replace the indefinite language with claim language, which precisely and particularly defines the invention. The preferred way to correct the lack of antecedent problem or other types of similar problems that have been raised above would be to provide a clear antecedent basis for the feature rather than to delete the language. Deleting features, which are presently in the claims, broadens the scope of the claims and thus may render the indication of allowable subject matter no longer

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applicable. Note that the examiner reserves the portion of requiring restriction and/or election, in due course, pursuant to MPEP 821.03, MPEP 811, etc., based on applicant's response to this office action.

10. Ekeroth (6105730) corresponds to submitted WO 96/41970.
11. Ward (6129183) and Ward et al (494) correspond to submitted WO 97/29298.
12. GB2258704 to Brearley et al discloses a brake wear indicator with rack and wheel (pinion).
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exmr. Butler whose telephone number is (703) 308-2575. The examiner can normally be reached on Monday to Friday from 5:30 a.m. to 2 p.m.

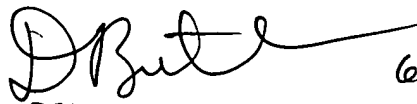
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Lavinder, can be reached on (703) 308-3421. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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 6/12/04
DOUGLAS C. BUTLER
PRIMARY EXAMINER
Art 3683

Butler/vs
June 8, 2004